

AF
3627
JW

PTO/SB/21 (09-04)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission 31

Application Number	09/672,435
Filing Date	09/28/2000
First Named Inventor	John K. Gerken III
Art Unit	3627
Examiner Name	James S. McClellan
Attorney Docket Number	RAL920000034US1

ENCLOSURES (Check all that apply)

- ☐ Fee Transmittal Form
 - ☐ Fee Attached
- ☐ Amendment/Reply
 - ☐ After Final
 - ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Reply to Missing Parts/Incomplete Application
 - ☐ Reply to Missing Parts under 37 CFR 1.52 or 1.53

- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a Provisional Application
- ☐ Power of Attorney, Revocation
- ☐ Change of Correspondence Address
- ☐ Terminal Disclaimer
- ☐ Request for Refund
- ☐ CD, Number of CD(s) _____
- ☐ Landscape Table on CD

- ☐ After Allowance Communication to TC
- ☐ Appeal Communication to Board of Appeals and Interferences
- ☒ Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
- ☐ Proprietary Information
- ☐ Status Letter
- ☒ Other Enclosure(s) (please identify below):
Request for Reinstatement of Appeal

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Winstead Sechrest & Minick P.C.		
Signature			
Printed name	Robert A. Voigt, Jr.		
Date	05/04/2005	Reg. No.	47,159

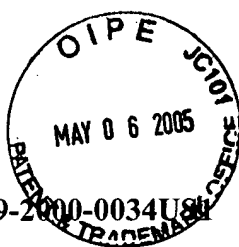
CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature			
Typed or printed name	Toni Stanley	Date	05/04/2005

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



RAL9-2000-0034US

PATENT

- 1 -

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	:	Before the Examiner:
Gerken et al.	:	James S. McClellan
Serial No.: 09/672,435	:	Group Art Unit: 3627
Filed: September 28, 2000	:	
Title: CUSTOMER CHECKOUT	:	IBM Corporation
ACCELERATOR	:	P.O. Box 12915
	:	Dept. 9CCA, Bldg. 002
	:	Research Triangle Park, NC 27709

REQUEST FOR REINSTATEMENT OF APPEAL

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action (Paper No. 17) having a mailing date of February 8, 2005, reopening prosecution of the above-referenced Application, Applicants respectfully request reinstatement of the Appeal based on the Appeal Brief filed on February 23, 2004, the Supplemental Appeal Brief filed on August 16, 2004 and the Notice of Appeal filed on January 21, 2004.

CERTIFICATION UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on May 4, 2005.

Signature

Toni Stanley

Toni Stanley

(Printed name of person certifying)

A supplemental appeal brief is filed herewith.

FEE DEFICIENCY

NOTE: If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, 1065 O.G. 31-33.

- ☒ If any additional extension and/or fee is required, this is a request therefor and to charge Account No. 50-0563 (RAL9-2000-0034US1).

AND/OR

- ☒ If any additional fee for claims is required, charge Account No. 50-0563 (RAL9-2000-0034US1).

Respectfully submitted,

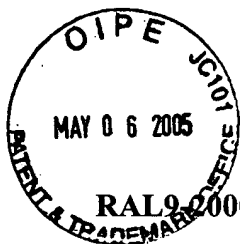
WINSTEAD SECHREST & MINICK P.C.

Attorneys for Applicants

By: _____

Kelly K. Kordzik
Reg. No. 36,571
Robert A. Voigt, Jr.
Reg. No. 47,159

P.O. Box 50784
Dallas, Texas 75201
(512) 370-2832



RAL92000-0034US1

PATENT

- 1 -

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	:	Before the Examiner:
Gerken et al.	:	James S. McClellan
Serial No.: 09/672,435	:	Group Art Unit: 3627
Filed: September 28, 2000	:	
Title: CUSTOMER CHECKOUT	:	IBM Corporation
ACCELERATOR	:	P.O. Box 12915
	:	Dept. 9CCA, Bldg. 002
	:	Research Triangle Park, NC 27709

SECOND SUPPLEMENTAL APPEAL BRIEF

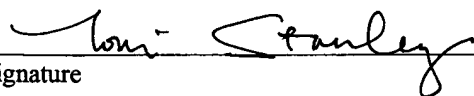
Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This second supplemental brief is being submitted pursuant to 37 C.F.R. §41.37.

CERTIFICATION UNDER 37 C.F.R. §1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on May 4, 2005.


Signature

Toni Stanley

(Printed name of person certifying)

I. INCORPORATION BY REFERENCE

Appellants hereby incorporate herein by reference Sections I and V of Appellant's Supplemental Amended Appeal Brief mailed on August 16, 2004.

II. STATUS OF CLAIMS

Claims 1-45 are pending in the Application. Claims 9, 10, 12-14, 31, 32 and 34-36 are allowed. Claims 1-5, 8, 11, 15-28, 33 and 37-45 stand rejected. Claims 1-5, 8, 11, 15-28, 33 and 37-45 are appealed.

III. NEW GROUND OF REJECTIONS TO BE REVIEWED ON APPEAL

Claims 1, 5, 8, 11, 24 and 33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bigari (U.S. Patent No. 5,010,485) in view of Heady et al. (U.S. Patent No. 6,275,200) (hereinafter "Heady"). Claims 2-4 and 25-28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bigari in view of Heady in further view of Yanagawa et al. (U.S. Patent No. 5,535,407) (hereinafter "Yanagawa"). Claims 15-23 and 37-45 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bigari in view of Heady and in further view of Terranova (U.S. Patent No. 6,098,879).

IV. ADDITIONAL ARGUMENTS

- A. Claims 1, 5, 8, 11, 24 and 33 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Bigari in view of Heady.

The Examiner has rejected claims 1, 5, 8, 11, 24 and 33 under 35 U.S.C. §103(a) as being unpatentable over Bigari in view of Heady. Paper No. 17, page 3. Appellants respectfully traverse these rejections for at least the reasons stated below.

1. The Examiner has not presented any objective evidence or source of motivation for combining Bigari with Heady.

A *prima facie* showing of obviousness requires the Examiner to establish, *inter alia*, that the prior art references teach or suggest, either alone or in combination, all of the limitations of the claimed invention, and the Examiner must provide a motivation or suggestion to combine or modify the prior art reference to make the claimed inventions. M.P.E.P. §2142. The showings must be clear and particular and supported by objective evidence. *In re Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433-34 (Fed. Cir. 2002); *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000); *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

The Examiner admits that Bigari does not teach to store an approval amount in a preapproval cache at a point of sales terminal for use in completing the sales transaction, as recited in claim 1 and similarly in claim 24. Paper No. 17, page 4. The Examiner's motivation for modifying Bigari with Heady to store an approval amount in a preapproval cache at a point of sales terminal for use in completing the sales transaction is "because providing cache for a processor allows the processor to operate more efficiently and at a higher speed because cache memory serves as a high-speed local memory source." Paper No. 17, page 4. The Examiner's motivation is insufficient to support a *prima facie* case of obviousness for at least the reasons stated below.

The Examiner has not presented a source for his motivation for modifying Bigari with Heady. The Examiner simply states "because providing cache for a processor allows the processor to operate more efficiently and at a higher speed because cache memory serves as a high-speed local memory source" as motivation for modifying Bigari with Heady to store an approval amount in a preapproval cache at a point of sales terminal for use in completing the sales transaction. The motivation to modify Bigari with Heady must come from one of three possible sources: the nature of the problem to be solved, the teachings of the prior art, and the knowledge

of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998). The Examiner has not provided any evidence that his motivation comes from any of these sources. Instead, the Examiner is relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claims 1, 5, 8, 11, 24 and 33. *Id.*

Furthermore, the Examiner's motivation is not a motivation as to why one of ordinary skill in the art with the primary reference (Bigari) in front of him would have been motivated to modify the primary reference (Bigari) with the teachings of the secondary reference (Heady). The motivation does not address as to why one of ordinary skill in the art would modify Bigari to store an approval amount in a preapproval cache at a point of sales terminal. The Examiner has not explained how installing a cache memory to improve the efficiency of the processor is related to storing an approval amount in a preapproval cache at a point of sales terminal. Instead, the Examiner is merely relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). The Examiner must provide objective evidence as to why one of ordinary skill in the art with Bigari in front of him, which teaches processing charge vouchers against charge card accounts administered by a host institution that issues an approval/disapproval to a merchant for a proposed transaction (Abstract of Bigari), would have been motivated to modify Bigari with Heady, which teaches an apparatus for controlling add-on equipment, such as an electronic display, with a guest controller transparently linked to an existing host computer system (column 3, lines 21-24 of Heady). *See In re Lee*, 61 U.S.P.Q.2d 1430, 1433-1434 (Fed. Cir. 2002); *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000). Merely stating to provide cache for a processor to allow the processor to operate more efficiently and at a higher speed is not evidence for combining Bigari with Heady. *See Id.* Consequently, the Examiner's motivation is insufficient to

support a *prima facie* case of obviousness for rejecting claims 1, 5, 8, 11, 24 and 33. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002).

As a result of the foregoing, Appellants respectfully assert that the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 1, 5, 8, 11, 24 and 33. M.P.E.P. §2143.

2. By combining Bigari with Heady, the principle of operation Bigari would change.

If the proposed modification or combination of the prior art would change the principle of the operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959). Further, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). For the reasons discussed below, Appellants submit that by combining Bigari with Heady, the principle of operation in Bigari would change and subsequently render the operation of Bigari to perform its purpose unsatisfactorily.

Bigari teaches that it is an object of the present invention to provide a new and useful system, apparatus and method for implementing credit purchases at locations which require rapid throughput of transaction events. Column 3, lines 12-15. Bigari further teaches a charge card reader that receives a customer charge card and reads information contained thereon to produce identification data corresponding to the charge card, with this identification data then being transmitted to the host institution by the data transmitter/receiver over the communication line opened by the autodialer. Column 4, lines 1-6. Bigari further teaches that the data processor is operative in response to transaction data entered by the manual entry means to interrogate the host institution by way of the data transmitter/receiver in order to obtain the approval/disapproval status signal for the proposed charge. Column 4, lines 7-11. Bigari further teaches that the data processor is operative in response to an approval

signal to produce a print signal. Column 4, lines 11-13. Bigari further teaches means, such as a printer, is provided to produce a voucher for a maximum approved charge corresponding to the proposed charge in response to a print signal; this voucher is indexed with both transaction identification data and maximum approved charge data entered thereon by the printer. Column 4, lines 13-18. Bigari further teaches that the customer endorses the voucher, still at the location remote from the point of purchase station. Column 4, lines 19-22. Bigari further teaches that the voucher thus becomes valid for the maximum amount of the proposed charge. Column 4, lines 20-22. Bigari further teaches that the card holder only then approaches the point of purchase station and places his/her order for goods or services and the actual transaction is totaled. Column 4, lines 22-25. Bigari further teaches that the attendant of the point of purchase station updates the voucher for an actual charge amount less than or equal to the maximum purchase amount approved by the host institution. Column 4, lines 25-28.

Heady, on the other hand, teaches conducting business transactions while the user remains in an automobile or at a walk-up structure. Column 1, lines 37-47. Heady further teaches controlling an electronic display by using a guest controller transparently linked to an existing host computer system or network. Abstract. Heady further teaches that the host computer network is typically a serial network of point-of-sale (POS) electronic cash registers wherein one register functions as the network server. Abstract. Heady further teaches that the guest controller "listens" to information transferred in the host computer system or network and produces output to the electronic display according to predetermined preferences and formats. Abstract. Heady further teaches that the guest controller and the electronic display system are manipulated and programmed using existing host input devices, such as a register keypad, without any obvious effect upon the existing computer system or network. Abstract. Heady further teaches that the method and apparatus are particularly useful to a business providing drive-thru ordering of products, such as a fast-food restaurant. Abstract.

Hence, by combining Bigari and Heady, Bigari would not be able to allow credit purchases which may be implemented at purchase stations. Instead, Bigari would have to be modified to control an electronic display, as taught in Heady. As stated above, the purpose of Bigari is to implement credit purchases. As stated above, Heady teaches controlling an electronic display, such as at a fast food restaurant, by a guest controller transparently linked to a host computer system. Hence, by combining Bigari with Heady, Bigari would be modified to controlling electronic displays instead of implementing credit purchases. Hence, by combining Bigari with Heady, the principle of operation in Bigari would change and subsequently render the operation of Bigari to perform its purpose unsatisfactorily. Therefore, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 1, 5, 8, 11, 24 and 33. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959); *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

3. The Examiner has not presented a reasonable expectation of success when combining Bigari with Heady.

The Examiner must present a reasonable expectation of success in combining Bigari with Heady in order to establish a *prima facie* case of obviousness. M.P.E.P. §2143.02. As stated above, Bigari teaches implementing credit purchases at locations which require rapid throughput of transaction events. Heady, on the other hand, teaches controlling an electronic display by using a guest controller transparently linked to an existing host computer system or network. The Examiner has not presented any evidence that there would be a reasonable expectation of success in combining Bigari, which teaches implementing credit purchases at locations which require rapid throughput of transaction events, with Heady, which teaches controlling an electronic display. The Examiner has not provided any evidence as to how a system that implements credit purchases would be combined with a system that controls an electronic display. Consequently, the Examiner has not provided a *prima facie* case of obviousness for rejecting claims 1, 5, 8, 11, 24 and 33. M.P.E.P. §2143.02.

4. Bigari and Heady, taken singly or in combination, do not teach or suggest the following claim limitations.

a. Claims 1 and 24 are patentable over Bigari in view of Heady.

Appellants respectfully assert that Bigari and Heady, taken singly or in combination, do not teach or suggest "storing the approval amount in a preapproval cache at a point of sales terminal for use in completing the sales transaction" as recited in claim 1 and similarly in claim 24. The Examiner states:

Bigari fails to expressly disclose storing the preapproval amount in a preapproval cache at a point of sales terminal. After inputting the preapproval amount via voucher reader 34, Bigari is silent as to where or how the preapproval amount is stored in anticipation of processing by the point of sale terminal. Heady teaches the use of a point of sales terminal (310) that includes a processor (410) that further comprises cache memory (see column 5, lines 20-25) that assists in executing software routines. Paper No. 17, page 4.

Appellants respectfully traverse that Bigari and Heady, taken in combination, teach the above-cited claim limitation. The Examiner is mistaken that Bigari teaches storing a preapproval amount at a point of sales terminal. Bigari instead teaches a payment voucher apparatus (Figure 1) that receives both the account identification data of a member charge card and the maximum charge amount by the host institution. Column 7, lines 49-51. Bigari further teaches that the host institution determines whether the correlated customer account has available credit line funds at least equal to the maximum charge amount. Column 7, lines 53-56. Bigari further teaches that if such funds are available, the host institution issues an approval status signal and reserves or "holds" funds from the customer account equal to the approved maximum charge amount. Column 7, lines 56-60. Bigari further teaches that if the maximum charge amount was approved, microprocessor 12 stores the maximum charge amount. Column 8, lines 6-7. Bigari further teaches that generating a voucher that includes both account identification data as well as the maximum charge amount permitted. Column 8, lines 8, lines 10-20. However, Bigari further teaches that the

customer then endorses the voucher, still at the location remote from the point of purchase station. Column 4, lines 19-22. Hence, Bigari teaches storing a maximum charge amount at a location remote from the point of purchase station. Bigari does not teach storing a maximum charge amount at a point of sale terminal as asserted by the Examiner.

Furthermore, Heady does not teach storing the approval amount in a preapproval cache at a point of sales terminal. There is no language in Heady that teaches storing an approval amount. Appellants performed a search of the term "approval" and were unable to identify these terms or any variations thereof in Heady. Further, there is no language in Heady that teaches storing an approval amount in a preapproval cache at a point of sales terminal.

Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 1 and 24, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

- b. Claims 5, 8, 11 and 33 are patentable over Bigari in view of Heady for at least the reasons claims 1 and 24 are patentable over Bigari in view of Heady.

Claims 5, 8 and 11 recite combinations of features including the combinations recited in claim 1 and thus are patentable over Bigari in view of Heady for at least the reasons claim 1 is allowable. Further, claim 33 recites combinations of features including the combinations in claim 24 and thus is patentable over Bigari in view of Heady for at least the reasons claim 24 is allowable.

- B. Claims 2-4 and 25-28 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Bigari in view of Heady and in further view of Yanagawa.

The Examiner has rejected claims 2-4 and 25-28 under 35 U.S.C. §103(a) as being unpatentable over Bigari in view of Heady and in further view of Yanagawa.

Paper No. 17, page 4. Appellants respectfully traverse these rejections for at least the reasons stated below.

1. The Examiner has not presented any objective evidence or source of motivation for combining Bigari and Heady with Yanagawa.

As stated above, a *prima facie* showing of obviousness requires the Examiner to establish, *inter alia*, that the prior art references teach or suggest, either alone or in combination, all of the limitations of the claimed invention, and the Examiner must provide a motivation or suggestion to combine or modify the prior art reference to make the claimed inventions. M.P.E.P. §2142. The showings must be clear and particular and supported by objective evidence. *In re Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433-34 (Fed. Cir. 2002); *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000); *In re Dembiczak*, 50 U.S.P.Q.2d. 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

The Examiner admits that Bigari in view of Heady does not teach transmitting the preapproval amount from a customer checkout accelerator to a store controller, as recited in claim 2 and similarly in claim 25. Paper No. 17, page 4. The Examiner's motivation for modifying Bigari and Heady with Yanagawa to transmit the preapproval amount from a customer checkout accelerator to a store controller is "because store controllers serve as a processing hub for a plurality of POS terminal, wherein decreasing the amount of processing power and memory storage capacity required by the POS terminals." Paper No. 17, page 4. The Examiner's motivation is insufficient to support a *prima facie* case of obviousness for at least the reasons stated below.

The Examiner has not presented a source for his motivation for modifying Bigari and Heady with Yanagawa. The Examiner simply states "because store controllers serve as a processing hub for a plurality of POS terminal, wherein

decreasing the amount of processing power and memory storage capacity required by the POS terminals" as motivation for modifying Bigari and Heady with Yanagawa to transmit the preapproval amount from a customer checkout accelerator to a store controller. The motivation to modify Bigari and Heady with Yanagawa must come from one of three possible sources: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998). The Examiner has not provided any evidence that his motivation comes from any of these sources. Instead, the Examiner is relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claims 2-4 and 25-28. *Id.*

Furthermore, the Examiner's motivation is not a motivation as to why one of ordinary skill in the art with the primary reference (Bigari) in front of him would have been motivated to modify Bigari with the teachings of a secondary reference (Yanagawa). The motivation does not address as to why one of ordinary skill in the art would modify Bigari to transmit the preapproval amount from a customer checkout accelerator to a store controller. The Examiner has not explained how decreasing the amount of processing power and memory storage capacity (Examiner's motivation) is related to transmitting a preapproval amount from a customer checkout accelerator to a store controller. Instead, the Examiner is merely relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). The Examiner must provide objective evidence as to why one of ordinary skill in the art with Bigari in front of him, which teaches processing charge vouchers against charge card accounts administered by a host institution that issues an approval/disapproval to a merchant for a proposed transaction (Abstract of Bigari), would have been motivated to modify Bigari and Heady with Yanagawa, which teaches processing transactions at a high speed, while avoiding the occurrence of transactional risk borne by stores or

banks (column 2, lines 37-39 of Yanagawa). *See In re Lee*, 61 U.S.P.Q.2d 1430, 1433-1434 (Fed. Cir. 2002); *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000). Merely stating to decrease the amount of processing power and memory storage capacity is not evidence for combining Bigari and Heady with Yanagawa. *See Id.* Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claims 2-4 and 25-28. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002).

As a result of the foregoing, Appellants respectfully assert that the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 2-4 and 25-28. M.P.E.P. §2143.

2. By combining Bigari with Yanagawa, the principle of operation Bigari would change.

As stated above, if the proposed modification or combination of the prior art would change the principle of the operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959). Further, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). For the reasons discussed below, Appellants submit that by combining Bigari with Yanagawa, the principle of operation in Bigari would change and subsequently render the operation of Bigari to perform its purpose unsatisfactorily.

Bigari teaches that it is an object of the present invention to provide a new and useful system, apparatus and method for implementing credit purchases at locations which require rapid throughput of transaction events. Column 3, lines 12-15. Bigari further teaches a charge card reader that receives a customer charge card and reads information contained thereon to produce identification data corresponding to the

charge card, with this identification data then being transmitted to the host institution by the data transmitter/receiver over the communication line opened by the autodialer. Column 4, lines 1-6. Bigari further teaches that the data processor is operative in response to transaction data entered by the manual entry means to interrogate the host institution by way of the data transmitter/receiver in order to obtain the approval/disapproval status signal for the proposed charge. Column 4, lines 7-11. Bigari further teaches that the data processor is operative in response to an approval signal to produce a print signal. Column 4, lines 11-13. Bigari further teaches means, such as a printer, is provided to produce a voucher for a maximum approved charge corresponding to the proposed charge in response to a print signal; this voucher is indexed with both transaction identification data and maximum approved charge data entered thereon by the printer. Column 4, lines 13-18. Bigari further teaches that the customer endorses the voucher, still at the location remote from the point of purchase station. Column 4, lines 19-22. Bigari further teaches that the voucher thus becomes valid for the maximum amount of the proposed charge. Column 4, lines 20-22. Bigari further teaches that the card holder only then approaches the point of purchase station and places his/her order for goods or services and the actual transaction is totaled. Column 4, lines 22-25. Bigari further teaches that the attendant of the point of purchase station updates the voucher for an actual charge amount less than or equal to the maximum purchase amount approved by the host institution. Column 4, lines 25-28.

Yanagawa, on the other hand, teaches that it is an object of the present invention to provide a customer data processing system capable of processing transactions at a high speed, while avoiding the occurrence of transactional risk borne by stores or banks. Column 2, lines 37-39. Yanagawa further teaches a customer data processing system that includes a host computer for managing customer data and a plurality of processors interconnected with the host computer through telecommunications lines. Abstract. Yanagawa further teaches that the host computer has a first storage unit for storing customer data and a customer data batch extracting

unit for extracting customer data with a high frequency of use out of the customer data stored therein and for transmitting the extracted customer data in a batch to the processors at predetermined times. Abstract. Yanagawa further teaches that each processor has a second storage unit for storing the customer data fed in a batch from the host computer and local updating unit for updating customer data stored in the second storage unit when a transaction with a customer is concluded. Abstract. Yanagawa further teaches that each processor also has a remote updating unit for updating customer data stored in the host computer through the telecommunications line. Abstract. Yanagawa further teaches that each processor has a customer data batch updating unit for transmitting the customer data updated in the local updating unit to the host computer in batch at a predetermined times. Abstract. Yanagawa further teaches that in this way, transactions can be processed at high speed, resulting in improved efficiency and security against tapping and so forth. Yanagawa further teaches that a centralized management system which includes a host computer and which manages customer data pertaining to transactions by computers at remote facilities, the customer data processing system being capable of efficiently updating the customer data. Column 1, lines 16-21.

Hence, by combining Bigari and Yanagawa, Bigari would not be able to allow credit purchases which may be implemented at purchase stations. Instead, Bigari would have to be modified to manage customer data pertaining to transactions by computers at remote facilities, as taught in Yanagawa. As stated above, the purpose of Bigari is to implement credit purchases. As stated above, Yanagawa teaches a centralized management system which includes a host computer and which manages customer data pertaining to transactions by computers at remote facilities, the customer data processing system being capable of efficiently updating the customer data. Hence, by combining Bigari with Yanagawa, Bigari would be modified to manage customer data pertaining to transactions by computers at remote facilities instead of implementing credit purchases. Hence, by combining Bigari with Yanagawa, the principle of operation in Bigari would change and subsequently render

the operation of Bigari to perform its purpose unsatisfactorily. Therefore, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 2-4 and 25-28. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959); *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

3. The Examiner has not presented a reasonable expectation of success when combining Bigari with Yanagawa.

The Examiner must present a reasonable expectation of success in combining Bigari with Yanagawa in order to establish a *prima facie* case of obviousness. M.P.E.P. §2143.02. As stated above, Bigari teaches implementing credit purchases at locations which require rapid throughput of transaction events. Yanagawa, on the other hand, teaches a centralized management system which includes a host computer and which manages customer data pertaining to transactions by computers at remote facilities, the customer data processing system being capable of efficiently updating the customer data. The Examiner has not presented any evidence that there would be a reasonable expectation of success in combining Bigari, which teaches implementing credit purchases at locations which require rapid throughput of transaction events, with Yanagawa, which teaches managing customer data pertaining to transactions by computers at remote facilities. The Examiner has not provided any evidence as to how a system that implements credit purchases would be combined with a system that manages customer data pertaining to transactions by computers at remote facilities. Consequently, the Examiner has not provided a *prima facie* case of obviousness for rejecting claims 2-4 and 25-28. M.P.E.P. §2143.02.

4. Bigari, Heady and Yanagawa, taken singly or in combination, do not teach or suggest claims 2-4 and 25-28.

Appellants respectfully assert that Bigari, Heady and Yanagawa, taken singly or in combination, do not teach or suggest "the act of transmitting the preapproval amount from the customer checkout accelerator to a store controller" as recited in claim 2 and similarly in claim 25. Appellants further assert that Bigari, Heady and

Yanagawa, taken singly or in combination, do not teach or suggest "placing an entry in a preapproval database if the external card services system approves the transaction amount" as recited in claim 3 and similarly in claim 26. Appellants further assert that Bigari, Heady and Yanagawa, taken singly or in combination, do not teach or suggest "notifying a point of sales terminal of the approval amount" as recited in claim 4 and similarly in claim 27. Appellants further assert that Bigari, Heady and Yanagawa, taken singly or in combination, do not teach or suggest "program instructions that determine if the payment card is one or more of a credit card, a debit card, a customer loyalty card, an electronic/Internet wallet or an electronic gift certificate" as recited in claim 28.

The Examiner has not cited to any passage in either Bigari, Heady or Yanagawa as teaching any of the above-cited claim limitations. The Examiner is reminded that in order to establish a *prima facie* case of obviousness, the Examiner must present a prior art reference (or reference when combined) that teach or suggest all the claim limitations. M.P.E.P. §2143. The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. M.P.E.P. §2142. Since the Examiner has not presented any evidence that either Bigari, Heady or Yanagawa teach any of the above-cited claim limitations, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 2-4 and 25-28. M.P.E.P. §2142.

5. Claims 2-4 and 25-28 are patentable over Bigari in view of Heady and in further view of Yanagawa for at least the reasons stated in Section A.

Claims 2-4 and 25-28 recite combinations including the combinations of claims 1 and 24, respectively, and hence are patentable over Bigari in view of Heady and in further view of Yanagawa for at least the reasons stated in Section A.

- C. Claims 15-23 and 37-45 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Bigari in view of Heady and in further view of Terranova.

The Examiner has rejected claims 15-23 and 37-45 under 35 U.S.C. §103(a) as being unpatentable over Bigari in view of Heady and in further view of Terranova. Paper No. 17, page 5. Appellants respectfully traverse these rejections for at least the reasons stated below.

1. The Examiner has not presented any objective evidence or source of motivation for combining Bigari and Heady with Terranova.

As stated above, a *prima facie* showing of obviousness requires the Examiner to establish, *inter alia*, that the prior art references teach or suggest, either alone or in combination, all of the limitations of the claimed invention, and the Examiner must provide a motivation or suggestion to combine or modify the prior art reference to make the claimed inventions. M.P.E.P. §2142. The showings must be clear and particular and supported by objective evidence. *In re Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433-34 (Fed. Cir. 2002); *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000); *In re Dembiczak*, 50 U.S.P.Q.2d. 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

The Examiner admits that Bigari in view of Heady does not teach to display on a customer checkout accelerator a selection of special promotional merchandise that can be added to the sales transaction where some or all of the promotional merchandise can be made available through a hyperlink to one or more Internet web sites, as recited in claim 15 and similarly in claim 37. Paper No. 17, page 5. The Examiner's motivation for modifying Bigari and Heady with Terranova to display on a customer checkout accelerator a selection of special promotional merchandise that can be added to the sales transaction where some or all of the promotional merchandise can be made available through a hyperlink to one or more Internet web

sites is "because utilizing the customer display to advertise to customers will increase the likelihood of additional sales while the customer is merely waiting and further provides a higher level of service to the customer." Paper No. 17, page 5. The Examiner's motivation is insufficient to support a *prima facie* case of obviousness for at least the reasons stated below.

The Examiner has not presented a source for his motivation for modifying Bigari and Heady with Terranova. The Examiner simply states "because utilizing the customer display to advertise to customers will increase the likelihood of additional sales while the customer is merely waiting and further provides a higher level of service to the customer" as motivation for modifying Bigari and Heady with Terranova to display on a customer checkout accelerator a selection of special promotional merchandise that can be added to the sales transaction where some or all of the promotional merchandise can be made available through a hyperlink to one or more Internet web sites. The motivation to modify Bigari and Heady with Terranova must come from one of three possible sources: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998). The Examiner has not provided any evidence that his motivation comes from any of these sources. Instead, the Examiner is relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claims 15-23 and 37-45. *Id.*

Furthermore, the Examiner's conclusion of obviousness is based on improper hindsight reasoning. The Examiner's motivation "because utilizing the customer display to advertise to customers will increase the likelihood of additional sales while the customer is merely waiting and further provides a higher level of service to the customer" appears to have been gleaned from Appellants' disclosure. Any judgment

on obviousness must not include knowledge gleaned from Appellants' disclosure. *In re McLaughlin*, 170 U.S.P.Q. 209, 212 (C.C.P.A. 1971). Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claims 15-23 and 37-45. M.P.E.P. §2145.

As a result of the foregoing, Appellants respectfully assert that the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 15-23 and 37-45. M.P.E.P. §2143.

2. By combining Bigari with Terranova, the principle of operation Bigari would change.

As stated above, if the proposed modification or combination of the prior art would change the principle of the operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959). Further, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). For the reasons discussed below, Appellants submit that by combining Bigari with Terranova, the principle of operation in Bigari would change and subsequently render the operation of Bigari to perform its purpose unsatisfactorily.

As stated above, Bigari teaches that it is an object of the present invention to provide a new and useful system, apparatus and method for implementing credit purchases at locations which require rapid throughput of transaction events. Column 3, lines 12-15. Bigari further teaches a charge card reader that receives a customer charge card and reads information contained thereon to produce identification data corresponding to the charge card, with this identification data then being transmitted to the host institution by the data transmitter/receiver over the communication line

opened by the autodialer. Column 4, lines 1-6. Bigari further teaches that the data processor is operative in response to transaction data entered by the manual entry means to interrogate the host institution by way of the data transmitter/receiver in order to obtain the approval/disapproval status signal for the proposed charge. Column 4, lines 7-11. Bigari further teaches that the data processor is operative in response to an approval signal to produce a print signal. Column 4, lines 11-13. Bigari further teaches means, such as a printer, is provided to produce a voucher for a maximum approved charge corresponding to the proposed charge in response to a print signal; this voucher is indexed with both transaction identification data and maximum approved charge data entered thereon by the printer. Column 4, lines 13-18. Bigari further teaches that the customer endorses the voucher, still at the location remote from the point of purchase station. Column 4, lines 19-22. Bigari further teaches that the voucher thus becomes valid for the maximum amount of the proposed charge. Column 4, lines 20-22. Bigari further teaches that the card holder only then approaches the point of purchase station and places his/her order for goods or services and the actual transaction is totaled. Column 4, lines 22-25. Bigari further teaches that the attendant of the point of purchase station updates the voucher for an actual charge amount less than or equal to the maximum purchase amount approved by the host institution. Column 4, lines 25-28.

Terranova, on the other hand, teaches a fueling system for automatically providing predefined customer preferences during a fueling operation. Abstract. Terranova further teaches that these preferences are typically selected by a customer and associated with a transponder that is issued to the customer. Abstract. Terranova further teaches that during a fuel transaction, the transponder transmits information that a fueling system uses to automatically provide select information to the customer according to the predefined preferences. Abstract.

Hence, by combining Bigari and Terranova, Bigari would not be able to implement credit purchases at locations which require rapid throughput of transaction events. Instead, Bigari would have to be modified to be a fueling station that would

receive customer preferences from a transponder issued to a customer instead of receiving a customer's charge card which is used to determine a maximum approved charge by a host institution. Hence, Bigari would no longer be able to print out a voucher for a maximum approved charge or perform any of the required steps in implementing credit purchases at locations which require rapid throughput of transaction events. Consequently, by combining Bigari with Terranova, the principle of operation in Bigari would change and subsequently render the operation of Bigari to perform its purpose unsatisfactorily. Therefore, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 15-23 and 37-45. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959); *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

3. The Examiner has not presented a reasonable expectation of success when combining Bigari with Terranova.

The Examiner must present a reasonable expectation of success in combining Bigari with Terranova in order to establish a *prima facie* case of obviousness. M.P.E.P. §2143.02. As stated above, Bigari teaches processing charge vouchers against charge card accounts administered by a host institution that issues an approval/disapproval to a merchant for a proposed transaction. Terranova, on the other hand, teaches a fueling system for automatically providing predefined customer preferences during a fueling operation. The Examiner has not presented any evidence that there would be a reasonable expectation of success in combining Bigari, which teaches processing charge vouchers against charge card accounts, with Terranova, which teaches a fueling system for automatically providing predefined customer preferences during a fueling operation. The Examiner has not provided any evidence as to how a system that teaches processing charge vouchers against charge card accounts would be combined with a fueling system that provides predefined customer preferences during a fueling operation. Consequently, the Examiner has not provided a *prima facie* case of obviousness for rejecting claims 15-23 and 37-45. M.P.E.P. §2143.02.

4. Bigari, Heady and Terranova, taken singly or in combination, do not teach or suggest the following claim limitations.

a. Claims 16, 21, 38 and 43 are patentable over Bigari in view of Heady and in further view of Terranova.

Appellants respectfully assert that Bigari, Heady and Terranova, taken singly or in combination, do not teach or suggest "creating a record of any additional items added to the sales transaction; appending the additional items record to a preapproval database entry for the sales transaction" as recited in claim 16 and similarly in claims 21, 38 and 43. The Examiner does not cite any passage in either Bigari, Heady or Terranova as teaching the above-cited claim limitation. Upon review of the references, Appellants respectfully assert that none of the references teach or suggest the above-cited claim limitation. The Examiner bears the initial burden and must submit objective evidence and not rely on his own subjective opinion in support of a *prima facie* case of obviousness. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992). Since the Examiner has not provided any evidence that Bigari, Heady and Terranova, taken singly or in combination, teach or suggest the above-cited claim limitation, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 16, 21, 38 and 43. M.P.E.P. §2143.

b. Claims 17, 22, 39 and 44 are patentable over Bigari in view of Heady and in further view of Terranova.

Appellants further assert that Bigari, Heady and Terranova, taken singly or in combination, do not teach or suggest "the act of reading the additional items record into a sales transaction record at a point of sale terminal" as recited in claim 17 and similarly in claims 22, 39 and 44. The Examiner does not cite any passage in either Bigari, Heady or Terranova as teaching the above-cited claim limitation. Upon review of both references, Appellants respectfully assert that none of the references teach or suggest the above-cited claim limitation. The Examiner is reminded that the Examiner bears the initial burden and must submit objective evidence and not rely on

his own subjective opinion in support of a *prima facie* case of obviousness. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992). Since the Examiner has not provided any evidence that Bigari, Heady and Terranova, taken singly or in combination, teach or suggest the above-cited claim limitation, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 17, 22, 39 and 44. M.P.E.P. §2143.

c. Claims 18 and 40 are patentable over Bigari in view of Heady and in further view of Terranova.

Appellants further assert that Bigari, Heady and Terranova, taken singly or in combination, do not teach or suggest "updating a vendor-based tracking database to bill the vendor for displaying a vendor advertisement on the customer checkout accelerator when the approval from the external card services system is approved" as recited in claim 18 and similarly in claim 40. The Examiner takes Office Notice that it is well known in the art to track advertisements for billing vendors. Paper No. 17, page 5. Appellants respectfully traverse the assertion that it is well known in the art to update a vendor-based tracking database to bill the vendor for displaying a vendor advertisement on the customer checkout accelerator when the approval from the external card services system is approved. Appellants respectfully request the Examiner to provide a reference that teaches the above-cited claim limitation pursuant to M.P.E.P. §2144.03. Appellants further note that the Examiner must consider all words in a claim, e.g., "when the approval from the external card services system is approved", "updating a vendor-based tracking database," in judging the patentability of claims 18 and 40 against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); M.P.E.P. §2143.03. Therefore, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 18 and 40. M.P.E.P. §2143.

Furthermore, the Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying Bigari to update a vendor-based tracking database to bill the vendor for displaying a vendor advertisement on the customer checkout accelerator when the approval from the external card services system is approved. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). The Examiner does not provide any motivation for modifying Bigari in such a manner. This is insufficient to support a *prima facie* case of obviousness. Consequently, the Examiner has not provided a *prima facie* case of obviousness in rejecting claims 18 and 40. *Id.*

Furthermore, Appellants respectfully assert that the Examiner's use of Official Notice is inappropriate. The Examiner is only to use Official Notice for facts asserted to be well-known or to be common knowledge in the art that are capable of instant and unquestionable demonstration as being well-known. *In re Ahlert*, 424 Fd.2d 1088, 1091, 165 U.S.P.Q. 418, 420 (C.C.P.A. 1970); M.P.E.P. § 2144.03. In this case, the facts asserted to be well-known or to be common knowledge in the art are not capable of instant and unquestionable demonstration as being well-known. Further, it is not appropriate for the Examiner to take Official Notice of facts without citing a prior art reference where the facts asserted to be well-known are not capable of instant and unquestionable demonstration as being well-known. *In re Ahlert*, 424 Fd.2d at 1091, 165 U.S.P.Q. 420-21; See also *In re Grose*, 592 Fd.2d 1161, 1167-68, 201 U.S.P.Q. 57, 63 (C.C.P.A. 1979). Further, it is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as a principle evidence upon which a rejection was based. *In re Zurko*, 258 F.3d 1379, 1385, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001). Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 18 and 40.

- d. Claims 19 and 41 are patentable over Bigari in view of Heady and in further view of Terranova.

Appellants further assert that Bigari, Heady and Terranova, taken singly or in combination, do not teach or suggest "configuring a selection of additional categories of items to be displayed on the customer checkout accelerator based on customer preferences wherein some or all of the categories of items can be made available through a hyperlink to one or more Internet web sites; and storing the category selections in a customer loyalty database that is maintained by the retail store" as recited in claim 19 and similarly in claim 41. The Examiner does not cite any passage in either Bigari, Heady or Terranova as teaching the above-cited claim limitation. Upon review of both references, Appellants respectfully assert that none of the references teach or suggest the above-cited claim limitation. The Examiner is reminded that the Examiner bears the initial burden and must submit objective evidence and not rely on his own subjective opinion in support of a *prima facie* case of obviousness. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992). Since the Examiner has not provided any evidence that Bigari, Heady and Terranova, taken singly or in combination, teach or suggest the above-cited claim limitation, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 19 and 41. M.P.E.P. §2143.

- e. Claims 23 and 45 are patentable over Bigari in view of Heady and in further view of Terranova.

Appellants further assert that Bigari, Heady and Terranova, taken singly or in combination, do not teach or suggest "updating a vendor-based tracking database to bill the vendor for displaying on the customer checkout accelerator a vendor advertisement for merchandise that can be made available through a hyperlink to the vendor's Internet web site when the approval from the external card services system is approved" as recited in claim 23 and similarly in claim 45. The Examiner takes Office Notice that it is well known in the art to track advertisements for billing vendors. Paper No. 17, page 5. Appellants respectfully traverse the assertion that it is well known in the art to update a vendor-based tracking database to bill the vendor for

displaying on the customer checkout accelerator a vendor advertisement for merchandise that can be made available through a hyperlink to the vendor's Internet web site when the approval from the external card services system is approved. Appellants respectfully request the Examiner to provide a reference that teaches the above-cited claim limitation pursuant to M.P.E.P. §2144.03. Appellants further note that the Examiner must consider all words in a claim, e.g., "when the approval from the external card services system is approved", "updating a vendor-based tracking database," in judging the patentability of claims 18 and 40 against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); M.P.E.P. §2143.03. Therefore, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 23 and 45. M.P.E.P. §2143.

Furthermore, the Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying Bigari to update a vendor-based tracking database to bill the vendor for displaying on the customer checkout accelerator a vendor advertisement for merchandise that can be made available through a hyperlink to the vendor's Internet web site when the approval from the external card services system is approved. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). The Examiner does not provide any motivation for modifying Bigari in such a manner. This is insufficient to support a *prima facie* case of obviousness. Consequently, the Examiner has not provided a *prima facie* case of obviousness in rejecting claims 23 and 45. *Id.*

Furthermore, Appellants respectfully assert that the Examiner's use of Official Notice is inappropriate. The Examiner is only to use Official Notice for facts asserted to be well-known or to be common knowledge in the art that are capable of instant and unquestionable demonstration as being well-known. *In re Ahlert*, 424 Fd.2d 1088, 1091, 165 U.S.P.Q. 418, 420 (C.C.P.A. 1970); M.P.E.P. § 2144.03. In this case, the facts asserted to be well-known or to be common knowledge in the art are not capable of instant and unquestionable demonstration as being well-known. Further, it

is not appropriate for the Examiner to take Official Notice of facts without citing a prior art reference where the facts asserted to be well-known are not capable of instant and unquestionable demonstration as being well-known. *In re Ahlert*, 424 Fd.2d at 1091, 165 U.S.P.Q. 420-21; See also *In re Grose*, 592 Fd.2d 1161, 1167-68, 201 U.S.P.Q. 57, 63 (C.C.P.A. 1979). Further, it is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as a principle evidence upon which a rejection was based. *In re Zurko*, 258 F.3d 1379, 1385, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001). Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 23 and 45.

5. Claims 15-23 and 37-45 are patentable over Bigari in view of Heady and in further view of Terranova for at least the reasons stated in Section A.

Claims 15-23 and 37-45 recite combinations including the combinations of claims 1 and 24, respectively, and hence are patentable over Bigari in view of Heady and in further view of Terranova for at least the reasons stated in Section A.

V. CONCLUSION

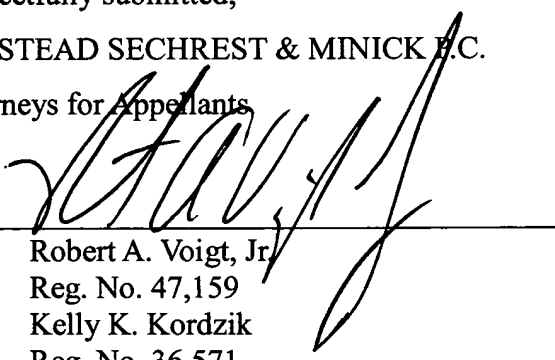
For at least the reasons stated above and in the Appeal Brief filed by Appellants on February 23, 2004 and in the Supplemental Appeal Brief filed by Appellants on August 16, 2004, the rejections of claims 1-5, 8, 11, 15-28, 33 and 37-45 are in error. Appellants respectfully request reversal of the rejections and allowance of claims 1-45.

Respectfully submitted,

WINSTEAD SECHREST & MINICK P.C.

Attorneys for Appellants

By: _____


Robert A. Voigt, Jr.
Reg. No. 47,159
Kelly K. Kordzik
Reg. No. 36,571

P.O. Box 50784
Dallas, Texas 75201
(512) 370-2832

Austin_1 279490v.1